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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,038	10/20/1999	CHASE A. HAFNER	1668	3569

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/421,038

Applicant(s)

HAFNER ET AL.

Examiner

Donald L. Champagne

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 20 October 1999 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 12 November 2004 has been entered.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Benyacar et al.
5. Benyacar et al. teaches a method, system and computer readable medium for managing information and rendering discounts in a billing system, the method comprising (col. 10 lines 44-59): receiving a customer record (AMA record 370) at billing system 140, where the

Art Unit: 3622

record includes the data shown in Fig. 3 (col. 7 line 16 to col. 10 line 27); executing the steps of Fig. 2 with the system of Fig. 1 (col. 5 line 41 to col. 7 line 15, and col. 10 lines 20-43), which reads on establishing both a rule-based accumulation engine and a rule-based discount engine, including *a non-application specific, configurable system* (para. 7-9 below) that process input data to produce output data where the processing is dictated by a set of *configurable* rules (para. 8 and 9 below); and generating the caller's and sponsor's billing records from the *AMA record*, including rendering discounts applicable to the customer.

6. Benyacar et al. does not explicitly teach accumulating the data in a plurality of predetermined target accumulators. However, under the principles of inherency (MPEP § 2111.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the reference teaches (col. 10 lines 44-59) substantially manipulating the data, which inherently entails placing data in computer memory locations, which reads on predetermined target accumulators.
7. Benyacar et al. teaches three a sets of parameters, *SCI*, *DDI* and *ASI*, that provide flexibility in various applications (col. 10 lines 22-27), including CSN arrangements other than that of AT&T (col. 5 lines 60-62), which reads on "a non-application specific system".
8. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".
9. The instant application contains no such clear definition for the phrases "configurable system" and "configurable rules". Indeed, the examiner could not find these phrases in the specification, and could only one reference (p. 3 line 17) to configuring a rules-based engine. Hence, the examiner is required to give the terms their broadest reasonable

Art Unit: 3622

interpretation. The *Microsoft Press Computer Dictionary* defines "configuration" and "configuration file" such that they apply to any computer. Since the reference teaches a computer whose memory, etc., can be changed, it teaches a "configurable system". The *Microsoft Press Computer Dictionary* definitions do not apply to software changes not established through configuration files. The broader definition in the *Merriam-Webster Online Dictionary* is used to establish that "configurable rules" are rules set up for operation in a particular way. The reference teaches that (para. 6above).

10. Claims 1-4, 6-14 and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Jagadish et al.
11. Jagadish et al. teaches (independent claims 1, 10 and 11) a method, system and computer readable medium for managing information and rendering discounts in a billing system, the method comprising: receiving a customer record (*AMA record*) at *billing analysis system 112* (col. line 22); and executing the steps of Fig. 2 with the system of Fig. 1a (col. 4 line 35-49), which reads on establishing both a rule-based accumulation engine and a rule-based discount engine, including a *non-application specific, configurable system* (para. 12 below) that process input data to produce output data where the processing is dictated by a set of *configurable* rules (para. 12 below); said processing the record and accumulating the data in *SD 113*, in a plurality of computer memory cells, which reads on a plurality of predetermined target accumulators, and rendering discounts applicable to the customer, which reads on processing the plurality of target accumulators with the discount engine to render discounts applicable to the customer.
12. Jagadish et al. teaches a flexible system of billing management (col. 4 lines 23-34), which reads on "a non-application specific system". Jagadish et al. also teaches a *configurable system* and a set of *configurable* rules for the reasons given in para. 9 and 10 above.
13. Jagadish et al. also teaches: (claims 2-4, 7, 8, 12-14, 17 and 18) the Fig. 2 series of process steps to be applied based on the number of customer lines, which reads on establishing a rules table to apply at least one rule or function when dictated by the record type, and establishing at least one simple rule for processing the record to evaluate discount application; (claims 6 and 16) adding the number of the telephone line to the record (col. 4 lines 47-54), which reads on assigning a logical name to a source field, where the

Art Unit: 3622

accumulation engine processes the record using the logical name; and (claims 9 and 19) establishing at least one compound rule composed of simple rules (col. 5 lines 10-23).

14. Claims 5 and 15 are rejected under 35 U.S.C. 102(e) as being obvious over Jagadish et al. Jagadish et al. does not teach that the rules table directs the accumulation engine to pass data directly to a target accumulator when dictated by the record type. Because the initial purpose of the reference invention is to aggregate all the phone line records for any given customer, it would have been obvious to one of ordinary skill in the art, at the time of the invention, that processing resources could be saved by bypassing this step, and passing the data directly to the target accumulators in *SD 112*, when the customer has only one line.

Conclusion

15. This is a continuation of applicant's earlier Application No. 09421048. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
16. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

Art Unit: 3622

18. The examiner's supervisor, Eric Stamber can be reached on 703-305-8469.¹ The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
20. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration. Applicant may have after final arguments considered and amendments entered by filing an RCE.
21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

26 February 2005

¹ 571-272-6724 after the middle of April, 2005.